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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,572	11/05/2001	Stephen Edward Cray	MSP584 DIV	1415

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,572

Applicant(s)

CRAY ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 20 is/are pending in the application.
- 4a) Of the above claim(s) 1, 5, 8, 16 to 18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 6, 7, 9 to 13, 15 and 19 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/614,471.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Applicant's election of Group II in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 2 and 7 are objected to because of the following informalities: a comma "," should be present after "an adhesion promoter" in component iv). Appropriate correction is required.

3. The Examiner notes that the "branched siloxane" required by each of the claims excludes the presence of "T" units in view of the "consisting of" language found in both claim 2 and 7. However the broad claims 2 and 7 do allow for the presence of "M" units having no alkenyl groups since R<sup>a</sup> can be alkyl.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 6, 7, 9-13, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 400 614, Ward et al. or WO 98/05723, as interpreted by Bohin et al.

WO 98/05723 (herein Bohin et al) teach silicone compositions for coating textile substrates. Column 6 teaches various branched organopolysiloxane polymers including MDQ resins. Note the bottom of column 12 which teaches MDQ resins in a composition also containing an organohydrogen crosslinker, a hydrosilylation catalyst and a linear alkenyl terminated polydiorganosiloxane, as well as an inhibitor and an adhesion promoter (each of which meet the optional component iv). This differs from that claimed only in that Bohin et al. fail to specifically state the number of "D" units in the MDQ resin. However the resin contains 76.5% by weight of "D" units. From this one having ordinary

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6, 9-13  
15, 19

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skill in the art would have been led to believe that there are a large number of D units in this resin, thereby suggesting an MDQ resin having from 15 to 995 D units. Column 6 teaches that the amount of "Q" units is preferably from 5 to 12% by weight which also indicates that there are a large number of "D" units in this resin. Note too that column 6 teaches that this resin functions to increase the mechanical strength of the silicone elastomer, as well as the adhesion. Adjusting the number of D units in this resin in an effort to optimize this properties would have been well within the skill of the ordinary artisan.

EP 400 614 teaches an organopolysiloxane composition. Note for instance the teachings starting on page 3, line 30, which show an organopolysiloxane resin having M, D and Q units (note that the D and T units are used in the alternative). Page 2 teaches that these compositions containing a platinum catalyst, and addition reaction inhibitor and an SiH containing crosslinking agent. Thus, again, the teachings of EP 400 614 differ from that claimed in that they do not specifically teach the number of D units in the resin. However page 3 teaches that the presence of the D units act to increase the compatibility of the resin with component (A). It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Ward et al. teach silicone elastomers. See column 4 which teaches the presence of MQD polymers. Note too claim 1 which teaches a composition containing the MQD resin, a dimethylvinyl terminated siloxane, an SiH crosslinking agent and a catalyst. This differs from the instant claims, again, in that Ward fails to specifically teach the number of D units in the resin. As can be seen from column 4, however, the D units must be present in an amount sufficient to lower the compression set by at least about 20%. Note too the suggested D to Q ratio taught on column 4. Thus it would have been well within routine experimentation and/or optimization of the teachings of Ward et al. for one having ordinary skill in the art to arrive at an MDQ resin having the required number of D units. In this manner, the instant claims are rendered obvious.

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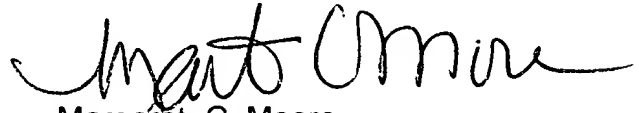
6. Claims 3, 4 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest a composition containing the required components of claim 2 in a multi-pack composition as required by these claims. Regarding claim 14, the prior art fails to teach or suggest this specific branched siloxane in a composition as claimed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
January 29, 2003